

R E M A R K S

Claims 1 to 12 and 14 to 21 as set forth in the Listing of Claims are currently pending.

Applicants have revised the wording of Claim 1 to require that the method is conducted by applying a herbicidally effective amount of the compound(s) of formula (I). Additionally, applicants have added a new Claim 21 which relates to a method corresponding to Claim 1 with the difference that a herbicidally effective amount of the compound(s) of formula (I) as defined in Claim 2 is employed. Claim 15 has been amended to require that m of formula (I) is 1 or 2, and Claim 20 has been revised to be independent from Claim 14. No new matter has been added.

The Examiner has indicated that Claims 2 to 9, 14 and 16 to 20 would be allowable if restricted with regard to the definition of X to CR² moieties, and has rejected Claims 1, 10 to 12 and 15 under 35 U.S.C. §102(b) as being anticipated by the teaching of *Charles et al.* (WO 00/46184).

It is respectfully noted that Claims 10 to 12 incorporate the limitations of Claim 2 by reference. Since the Examiner indicated Claim 2 as allowable to the extent that it has been examined, the same should apply where the subject matter of Claims 10 to 12 is concerned. New Claim 21 should equally be allowable to the same extent as Claim 2 since it also incorporated the limitations of Claim 2 by reference.

As concerns the Examiner's rejection of Claim 1 in view of the teaching of *Charles et al.* it is respectfully submitted that applicants' claim relates to a method wherein undesired plant growth at a locus is combatted by applying a herbicidally effective amount of at least one compound of applicants' formula (I) or an agronomically acceptable salt or N-oxide thereof.

In contrast to applicants' method, the disclosure of *Charles et al.* provides for a method wherein fungi are controlled by applying to a locus which is infested with fungi suitable amounts of a compound represented by *Charles et al.*'s formula (i). Although applicants' formula (I) as defined in Claim 1 overlaps in certain aspects with the generic range of *Charles et al.*'s formula (i) and *Charles et al.* disclose one embodiment of their compounds (i) which falls within the

realm of applicants' formula (I), the disclosure of **Charles et al.** cannot be considered as anticipating applicants' invention.

Anticipation under Section 102 can be found only if a reference shows exactly what is claimed. The test for anticipation is one of identity, cf. the identical invention must be shown in the reference in as complete detail as is contained in the claim¹⁾. As explained in the foregoing, applicants' invention requires the application of the compound of formula (I) to a locus at which undesired plant growth is present. **Charles et al.** does not address such a locus or even suggest that their compounds (i) are useful in such an environment. The teaching of **Charles et al.** therefore clearly fails to identically show what is defined in applicants' claim. It is also noted in this context that, based on the information which is provided by the disclosure of **Charles et al.**, an application of the compounds (i) to undesired plants at a locus cannot be deemed to serve any apparent purpose. A person of ordinary skill in the art would not have been motivated by the teaching of **Charles et al.** to apply the fungicidal compounds (i) to a locus at which undesired plant growth is present. The teaching of **Charles et al.** therefore not only fails to anticipate applicants' method within the meaning of Section 102, it also fails to render applicants' method *prima facie* obvious within the meaning of Section 103(a). Favorable reconsideration of the Examiner's position and withdrawal of the respective rejection is respectfully solicited.

As concerns the Examiner's rejection of Claim 15 in view of the teaching of **Charles et al.** it is respectfully submitted that applicants' amendment removes embodiments of compounds (I) which go beyond the realm of formula (I) as defined in Claim 2²⁾. Claim 15 should therefore be allowable to the same extent as Claim 2. It is respectfully requested that the respective rejection be withdrawn. Favorable action is solicited.

The Examiner has reiterated the requirement to restrict the claims with regard to the compounds (I) to those compounds (I) wherein X denotes a CR² moiety emphasizing that compounds (I) wherein X is CR² and compounds (I) wherein X is N are patentably distinct.

1) ie. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (CAFC 1989)

2) Claim 2 is now generic to Claim 15, the difference residing in the definition of R³ which is -according to Claim 15- not allowed to denote hydrogen.

It is respectfully requested that the Examiner favorably reconsider the restriction requirement in light of the criteria for a restriction between patentably distinct inventions which are provided in MPEP §803:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP §802.01, §806.04, § 808.01) or distinct as claimed (see MPEP §806.05 - §806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP §803.02, §806.04(a) - §806.04(i), §808.01(a), and §808.02).

(emphasis added). Applicants previously significantly reduced the scope of the claims so that the burden on the Examiner is no longer deemed to be serious. The two criteria for a proper requirement for restriction between patentably distinct inventions are therefore no longer deemed to be met. Favorable action is solicited.

REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a three month extension of time be granted in this case. A check for the \$950.00 fee is attached.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 11.0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

KEIL & WEINKAUF



Herbert B. Keil

Reg. No. 18,967

1350 Connecticut Ave, N.W.
Washington, D.C. 20036
(202) 659-0100

Encl.: THE LISTING OF CLAIMS (Appendix I)

HBK/BAS